



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,583	03/29/2004	Jay S. Walker	03-068	2063

22927 7590 01/31/2007
WALKER DIGITAL
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

SAGER, MARK ALAN

ART UNIT PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/811,583

Applicant(s)

WALKER ET AL.

Examiner

M. A. Sager

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/7/06, 10/4/06, 11/20/06.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17 and 33-45 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 15-17 and 33-45 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/4/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Double Patenting

1. Claims 15-16 and 33-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6361441. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to an artisan to claim the method of the gaming device or system or computer program product so as to correct the process of the invention. The claims of cited patents claim team result or outcome or totaling results/outcomes that is deemed to encompass claimed steps especially with respect to receiving input and generating an outcome or combining outcome and determining a payout based on the symbols or determining an outcome at a device determining an association and outputting an indication, as particularly claimed. Also, it would have been obvious to an artisan to cancel steps/features such as aspects regarding formation of team or determination of what constitutes a bonus from Walker where patentability does not lie therein so as to secure a broader form of invention. Walker '441 claims team result from teamed or associated play.

Terminal Disclaimer

2. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Claim Rejections - 35 USC § 102

3. Claims 15, 35-38, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Piechowiak (5580309). Gaming machine and gaming device are used interchangeably herein.

Art Unit: 3712

As best understood with broadest reasonable interpretation of claim language, Piechowiak discloses a method teaching receiving a first input at a first gaming device includes any game input at game machine such as spin/play or handle pull as conventional for slot/poker machine (2:25-35, 4:29-35, ref. 101), receiving a second input at a second gaming device where second gaming device may be same or another networked gaming machine (2:25-35, 4:29-35, 101-108), generating, based on both the first and second input, an outcome comprising a plurality of indicia includes where the feature controller generates an outcome based on combined results from individual gaming machines towards determining whether a feature is to be enabled (3:5-21), includes when a criteria for enablement is determined to have been met, the feature is enabled (3:21-29), includes awarding a prize after feature has been enabled (3:21-41, 54-59) and includes disabling the feature after a time period expires if no award is won (1:51-56, 2:11-3:65, 4:14-25, 29-35, fig. 1-2), but also includes general gaming machine operation of first and second gaming device each generating a game outcome based on player input at their respective gaming machine (2:11-30, 4:29-35, fig 1), in which the outcome comprises a plurality of symbols, the symbols derived from the reels of the first and second gaming devices such that the feature controller generates an outcome of a plurality of symbols derived from reels of first and second devices such as (1:51-56, 3:10-13, 22-25, 4:14-19) but also includes the particular symbols of the final displayed combination on each respective first and second gaming machine ((2:28-33, 4:29-35, fig 1) and determining an association between the players in so far as players playing on linked gaming machines (fig. 1).

Further, Piechowiak includes determining an outcome of a game obtained by a first player playing the game via a first device includes game output at a gaming machine or a

Art Unit: 3712

determination by feature controller that an outcome at a linked gaming machine is to be tabulated towards an enablement criteria or to enable a feature based on determining the criteria has been met or if no win within a predetermined period of an enabled feature, the feature controller determines to disable the feature (1:51-56, 2:11-3:65, 4:14-25, 29-35, fig. 1-2), determining a second player associated with first player, the second player playing a second device having a display thereon (2:25-35, 4:29-35, ref 102-108), outputting an indication of the outcome obtained which includes the feature controller determining if the game result obtained from the first game machine enables a feature (3:5-21), includes feature controller determining if game result obtained from first game machine wins an award of an enabled feature (3:21-29, includes awarding a prize after feature has been enabled (3:21-41, 54-59) and includes feature controller disabling the feature after a time period expires if no game result is obtained from first gaming machine for award to be won (1:51-56, 2:11-3:65, 4:14-25, 29-35, fig. 1-2), wherein the playing the first device at substantially the same time at which playing the second device (sic), first and second device in communication with a controller and the controller determines outcome has been obtained and in response causes output the indication via the display such as to display on gaming machine an indication of the outcome that the feature is enabled/disabled based upon feature controller determination (1:51-56, 2:11-3:65, 4:14-25, 29-35, fig. 1-2, ref. 202, 212, 213) and determining an association between the players in so far as players playing on linked gaming machines (sic).

Claim Rejections - 35 USC § 103

4. Claims 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piechowiak in view of Celona (5564700). Although Piechowiak discloses players playing at

Art Unit: 3712

linked gaming machines (101-108), it is not clear whether an association exists between players playing at linked machines. Celona discloses a method of linked gaming machines where players who meet threshold play requirements are associated together in a proportional payout (2:10-50, 3:8-9:12). Thus, rather than first to achieve wins all as in the competition play that discourages play for some players at linked machines due to the win all or nothing progressive payout taught by Piechowiak, the method taught by Celona encourages more camaraderie between the players at the linked machines due to each player earning a proportional payout since each player is more closely associated. Thus, it would have been obvious at time prior to invention to add determining an association between the players as taught by Celona to Piechowiak in order to increase interest in gaming at linked gaming machines.

5. Claims 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piechowiak in view of either Marks (5755621) or Guinn (6039648) or Thacher (5083271). Piechowiak discloses players playing at linked gaming machines (101-108) in a process comprising all steps (sic) except determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together, as claimed. However, team play in gaming devices is notoriously well known as demonstrated by Marks (16:14-15) or Guinn (2:1-5, 45-51, 8:15-19) or Thacher (18:29-36, fig. 1-2) that each teach team play by players on linked gaming machines. Some common team play scoring concepts include cumulative score or high/best score. Although Marks or Guinn or Thacher do not discuss such common details, the methodology of known team scoring processes are included since an inventor must disclose that material which is new but preferably omits

Art Unit: 3712

material that is old or conventional. Such is the case with Marks and Guinn and Thacher. It is further noted that Marks, Guinn and Thacher each clearly teach selective linking of gaming machines by players indicating a desire to be linked in tournament or competitive play. Some players enjoy competitive or tournament play as evidence by the saturation of tournaments or competitive play starting in elementary schools with sports or spelling bees through including professional sports (teamed or individual). Thus, it would have been obvious to an artisan at a time prior to the invention to add determining an association between the players, determining if the players are on a team together, determining if the players are on a team irrespective of position of the first and second gaming devices and detecting a representation from the players that they are on the team together as suggested/taught by Guinn or Marks or Thacher to Piechowiak in order to permit competition between groups or teamed players and to increase interest in linked progressive play thereby which increases revenue due to increased play.

Allowable Subject Matter

6. Claims 33-34 and 17 appear to contain allowable subject matter. It is noted that reference to claim 37 in allowable subject matter in prior action was a typo and was intended to be 17 and it is noted that claim 37 was examined in obviousness double patenting and art holdings.

Response to Arguments

7. Applicant's arguments filed Sep 7, 2006 and Nov 20, 2006 have been fully considered but they are not persuasive. Regarding Applicants request for withdrawal of double patenting rejection, the Office notes that submitted response is not persuasive due to counsel not being of record in this prosecution history to overcome holding. Perfecting a response may be considered a new issue.

Regarding Applicants statement that action must show each and every element, the office action provided elements or citations from reference where each and every element (step) was performed such that one of ordinary skill in the art would understand that Piechowiak gaming machine 101-108 or citations taught claimed steps. However, as a service and in preparation for consideration by board, the holding is clarified.

Regarding Applicants remark that Piechowiak does not teach a claim element (inputs come from first player and second player), that the action does not address a claim element, and that occurrences of predetermined combination of indicia are not inputs from the player, the examiner disagrees. With respect to action not addressing a claim element, the action may have taken liberty by paraphrasing claim language; however, all features were addressed with broadest reasonable interpretation thereto. In reply to the reference does not teach an element, Piechowiak discloses linked gaming machines to a feature controller that may enable/disable a feature based on game results obtained from inputs from players at gaming machines (1:51-56, 2:11-3:65, 4:14-25, 29-35, fig. 1-2). It is germane that gaming machines function or operate only in reply to player input, i.e. no automated play. Thus, examiner can only inquire [in reply to Applicants assertion that Piechowiak does not include either receiving a first input from a first player at a first gaming device or receiving a second input from a second player at a second gaming device], to Applicant whether they believe Piechowiak functions without player input. Further, in reply to Applicants assertion that occurrences of predetermined combination of indicia are not inputs from the player, the Applicants literal reading is not well taken at least for not considering the reference as a whole if not also in consideration of general operation of a gaming device as shown in holding above incorporated herein. The occurrences of the

Art Unit: 3712

predetermined combination of indicia are obtained from gaming results/outcomes that were initiated by player providing input such as start or handle pull selection to their respective gaming machine. This is common gaming machine operation. Applicants dismissal of general knowledge of gaming machine operation in arguing a reference does not teach claimed steps is noted and is not well taken. Perhaps, Applicant does not consider breadth of claims to its broadest reasonable interpretation such that a method comprising generating an outcome (paraphrased) does not preclude an outcome or outcomes from each respective gaming device at least since comprising an outcome does not preclude more than one outcome. Also, discussion regarding first and second player and first and second gaming device is incorporated herein.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the outcome must be displayed, the second player plays the output device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In particular, the claim includes in part 'second player playing a second device having a display' and 'outputting on the display device an indication of the outcome obtained by the first player'. In reply to remark regarding second player plays at second device, the examiner incorporates inquiry to Applicant whether they believe Piechowiak does not require player input or permits automated play. Further, first and second player are not defined to be different players such that first player and second player can be same individual playing at separate gaming device of Piechowiak (fig. 1, 101-108), as conventional for some individual -players to input coins into multiple contingent gaming machines in a bank of

Art Unit: 3712

machines and play each respective machine accordingly. It is also noted that first and second gaming device are not differentiated and can be same device. Thus, Piechowiak includes a second player playing a second device having an output display (2:11-30, 4:29-35, fig 1, ref 101-108). Also, contrary to Applicants remark that the outcome must be displayed, Piechowiak teaches outputting on the display an indication of the outcome on the display as either enable/disable or award bonus feature (1:51-56, 2:11-3:65, 4:14-25, 29-35, fig. 1-2, ref. 202, 212, 213) such that 'outputting on the display of the second device played by the second player an indication of the outcome obtained by a first player' where the first player is playing the game via a first device does not require a display of the outcome obtained on first device but includes Piechowiak determination of enable/disable or award bonus feature resultant from determination regarding outcome as an indication or, alternatively, the output on display of final displayed combination on gaming machine where first and second player may be same player or where first or second gaming device may be same device, and thus the output on gaming device of final outcome is as conventional.

8. Applicant's arguments with respect to claims 38-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

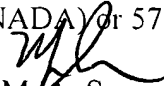
Art Unit: 3712

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


M. A. Sager
Primary Examiner
Art Unit 3712

mas